

AMENDMENT UNDER 37 C.F.R. § 1.116
U.S. APPLICATION NO.: 09/422,347
ATTORNEY DOCKET NO. Q56325

AMENDMENTS TO THE DRAWINGS

Applicants herein cancel Figure 2 as presented in the Rule 111 Amendment filed on June 28, 2005. Applicants attach hereto a new Figure 2 that depicts the compression device of the present invention. The specification is replete with support for the new Figure 2. See, *e.g.*, pages 6-8 of the original specification.

Attachment: Two (2) Replacement Drawing Sheets

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REMARKS

Claims 1-7, 9 and 11-20 have been examined on their merits.

Applicants herein amend claims 1, 7 and 20 to recite a compression device that compresses final destination addresses. Support for the amendments to claims 1, 7 and 20 can be found on pages 6-8 of the originally filed application.

Applicants herein amend dependent claims 11, 12, 13 and 17 to conform to the amendments to independent claim 1.

The amendments to claims 1, 7, 11-13, 17 and 20 do not add any new matter, and do not present any new issues requiring further search and/or consideration on the part of the Examiner, and reduce issues for appeal.

Claims 1-7, 9 and 11-20 are all the claims presently pending in the application.

1. The Patent Office objects to the Rule 111 Amendment of June 28, 2005 as containing new matter into the disclosure. In the interests of advancing the prosecution of this application, Applicants herein amend the specification to remove the alleged new matter, although the Examiner has completely failed to provide any cogent reasoning or arguments as to why the Rule 111 Amendment of June 28, 2005 introduces new matter. Although the Examiner claims that “the added material” was not supported by the original disclosure, Applicants note that the Examiner did not challenge Applicants’ reasoning as to why the amendments to the specification and the new Figure 2 (which the Examiner requested in previous Office Actions) was not new

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matter. As noted above, Applicants are removing the alleged new matter to advance the prosecution of this application and to remove issues for appeal.

2. Claims 1-7, 9 and 11-20 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Boivie (U.S. Patent No. 6,502,140). Applicants traverse the § 103(a) rejection of claims 1-7, 9 and 11-20 for at least the reasons discussed below.

The Examiner had previously acknowledged that the difference between independent claims 1 and 7 and Boivie lies in the type of addressing used. The Examiner has further acknowledged that the final destination addresses of independent claims 1 and 7 do not include references to the intermediate node(s), while Boivie's addressing scheme does reference intermediate node(s). The Examiner characterizes Applicants' inventive address compression technique as obvious to one of ordinary skill in the art because it would have the benefit of traffic reduction.

The characterization of certain claim limitations or parameters as obvious does not make the claimed invention, considered as a whole, obvious. The Examiner must establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This burden can only be satisfied by an objective teaching in the prior art or by cogent reasoning that the knowledge is available to one of ordinary skill in the art. *In re Lalu*, 747 F.2d 703, 223 U.S.P.Q. 1257 (Fed. Cir. 1984). Furthermore, the Examiner cannot rely on official notice, judicial notice or a mere statement of obviousness at the exact point where patentable novelty is argued, but must come forward with pertinent prior art. *Ex parte Cady*, 148

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U.S.P.Q. 162 (Bd. of App. 1965). Here, one of the points of novelty of the present invention is at least the exclusion of intermediate addresses from the compound destination address consisting only of compressed final destination addresses. The Examiner has not cited, nor has the Applicant identified, any prior art which suggests or teaches this, or any other novel aspects of the present invention found in claims 1-7, 9 and 11-20. As stated in the Response to Arguments section of the September 9, 2005 Final Office Action, the Examiner claims that, since IP packets do not specify intermediate nodes for the delivery of a packet to an intermediate node, that one of skill in the art would have used Boivie's addressing scheme, but without the inclusion of the intermediate addresses. However, the Examiner's hindsight-based analysis completely overlooks the fact that Boivie's addressing scheme uses the same type of IP packets that the Examiner claims that one of skill in the art would use to arrive at the present invention.

Furthermore, even when obviousness is based on a single prior art reference, there must be a showing of a suggestion or motivation to modify the teachings of that reference. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d at 1316-1317 (citing *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 U.S.P.Q.2d 1314, 1318 (Fed. Cir. 1996)); see also, *Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (B. Pat. App. & Inter. 1985)) ("To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references."). Here, the only evidence that is proffered by the Examiner is that it would have been obvious to modify Boivie based on the use of IP packets.

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As discussed in several previous submissions to the Patent Office, a compound address created under Boivie's disclosed method would be stymied in its transmission if, for some reason, intermediate addresses R1 or R2 were unreachable. Boivie discloses that if a routing error occurs, then the sending node (node A in Figure 1 of Boivie) is informed and the node A has to readjust its multicast tree. *See* col. 4, line 64 to col. 5, line 14 of Boivie. In other words, the intermediate addresses R1 and R2 are a necessary component of Boivie's addressing scheme. Applicants have devised a novel method of overcoming the above-discussed shortcomings of Boivie, and the Examiner continues to fail to come forward with any additional prior art and/or cogent reasoning (other than a bald assertion) as to why it would be obvious to one of ordinary skill to modify Boivie.

Finally, the burden is on the Patent Office to demonstrate using only objective evidence or suggestion from the applied prior art, that one of ordinary skill would have been lead to the claimed invention as a whole without recourse to Applicants' disclosure. *In re Oetiker*, 977 F.2d 1443, 1447-48, 24 U.S.P.Q.2d 1443, 1446-47 (Fed.Cir.1992); *In re Fine* 837 F.2d 1071, 1074-75, 5 U.S.P.Q.2d 1596, 1598-1600 (Fed.Cir.1988). As a matter of law then, it is the burden of the Examiner to demonstrate that the prior art, and not Applicants' disclosure, would lead the hypothetical artisan to the claimed invention as a whole. Here, the only mention of the compound destination address consisting only of compressed final destination addresses is in the Applicants' disclosure. The Examiner has not identified any text and/drawings in the disclosure of Boivie that would lead one of ordinary skill in the art to the invention recited in independent claims 1 and 7.

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Finally, with respect to the amendments to claims 1 and 20, Applicants remind the Examiner that a patent applicant “is free to recite features of an apparatus either structurally or functionally.” *In re Schreiber*, 128 F.3d 1473, 1478, 44 U.S.P.Q.2d 1429 (Fed. Cir. 1997), *citing* *In re Swinehart*, 439 F.2d 210, 212, 169 U.S.P.Q. 226, 228 (C.C.P.A. 1971). A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* MPEP § 2173.05(h).

Based on the foregoing reasons, Applicants submit that independent claim 1 is in condition for allowance over Boivie, and further submit that claims 2-6, 9, 11-13, 17, 19 and 20 are allowable as well, at least by virtue of their dependency from claim 1. Applicants request that the Patent Office withdraw the § 103(a) rejection of claims 1-6, 9, 11-13, 17, 19 and 20.

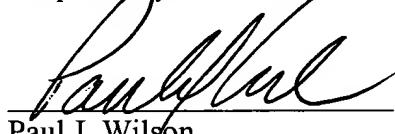
With respect to independent claim 7, Applicants submit that independent claim 7 is in condition for allowance for at least reasons analogous to those discussed above with respect to claim 1. Applicants further submit that claims 14-16 and 18 are allowable as well, at least by virtue of their dependency from claim 7. Applicants request that the Patent Office withdraw the § 103(a) rejection of claims 7, 14-16 and 18.

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In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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WASHINGTON OFFICE
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CUSTOMER NUMBER

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